

replacing it with “self-guiding,” the rejection of Claim 35 on the basis of noncompliance with 35 U.S.C § 112 ¶ 1 is traversed by the current amendment to Claim 35.

Claim Rejections – 35 U.S.C § 103

A. The Suggested Combinations do not Teach Every Limitation of the Invention Disclosed in Application 10/715,192

According to MPEP § 706.02(j), “[t]o establish a *prima facie* case of obviousness” for the purpose of rejecting a claim under 35 U.S.C. § 103, “the prior art reference (or references when combined) much teach or suggest all the claim limitations” of the claim being rejected. For the reasons that follow, the examiner of U.S. Patent Application Number 10/715,192 (the ‘192 application) has not met that burden with respect to her rejection of Claims 18-25, 27, 28, 33, 34, and 36 “under 35 U.S.C. § 103(a) as being unpatentable over Beranek et al. 2,478,558 (Beranek) in view of Shurman et al. 5,007,234 (Shurman),” set forth at ¶ 4 of the Final Office Action cited above. Since Claim 18 is the only independent claim of the ‘192 application, and all other rejections by the examiner fail if the rejection of Claim 18 based on Beranek in combination with Shurman fails, the failure of that combination to “teach or suggest all the claim limitations” of Claim 18 necessitates the failure of all other rejections cited by the examiner. Nevertheless, additional arguments against rejections of specified dependent claims follow as well.

Claim 18 of the amended ‘192 application as filed on July 10, 2006 reads:

Claim 18 (new): A rotary cutting apparatus comprising
a plurality of blades, each blade fixed to the end of a drive shaft in substantially perpendicular orientation to the shaft, each shaft projecting downward from a power means at an angle tilted longitudinally between 1 and 90 degrees from vertical,
a grass guide,
a chassis to which said rotary cutting apparatus is affixed, and
a means for effecting movement of the apparatus over a cutting surface.

The examiner noted in the Final Office Action that Beranek discloses:

- A replaceable blade (23) perpendicularly fixed to the end of a drive shaft (22) connected to a replaceable power means (16), the shaft (22) at a fixed angle ... tilted longitudinally between 1 and 90 degrees from vertical...
- A chassis (4,15)
- Means for effecting movement of the apparatus comprising:
 - A handle (5)
 - Wheels
- Wherein the power means comprises a single electric motor (16)

The examiner incorrectly asserted in the Final Office Action that Beranek discloses:

- A grass guide (35) that bends to constrain grass to be cut by the blade (23, by enclosing the grass inside the guide, the guide constrains the grass)

The component identified as (35) in the Beranek drawings, which the examiner identified as “a grass guide that bends to constrain grass to be cut by the blade” in the Final Office Action, is not a grass guide, nor does it constrain grass to be cut by the blade. This is because the cutting blade (23) in Beranek protrudes forward in the direction of the cutting path, below and beyond component (35), which Beranek et al. identify as a “guard.” Because the cutting blade protrudes forward beyond the guard, grass in the cutting path is cut by the blade without ever coming into contact with the guard. Since the guard does not contact the grass, it cannot “bend to constrain the grass,” and since the grass is cut by the blade before it can contact the guard, there is no “grass to be cut” that could be otherwise bent or constrained by the guard.

The grass guide (6) of the invention disclosed in the ‘192 application is situated forward of the blades of the rotary cutting apparatus of Claim 18, a feature which enables it to bend and constrain the grass in the blade paths such that the blades of the apparatus can cut the grass with less power required. That is why component (6) is called a “grass guide;” i.e., it guides the grass into a position such that it is cut by the cutting blades with reduced expenditure of power.

Because Beranek fails to disclose a grass guide in any enabled embodiment of his invention, and the examiner relied on Beranek in view of Shurman in rejecting Claim 18 of the ‘192 application, the examiner has not met the burden of showing that every feature of the invention embodied in Claims 18 is present in the combination relied upon in her rejection of that claim under 35 U.S.C. § 103(a). Therefore, that claim is not obvious under 35 U.S.C. § 103(a) in light of Beranek in view of Shurman according to the standard set forth in MPEP § 706.02(j).

Since the examiner made no objection pursuant to 35 U.S.C. § 112, ¶ 4, of any of Claims 19-36 of the amended ‘192 application, and Claims 19-36 all depend either directly or indirectly from Claim 18, it is assumed that Claims 19-36 are proper dependent claims. Pursuant to 35 U.S.C. § 112, ¶4:

[A] claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. **A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.**

Since a proper dependent claim necessarily must “incorporate by reference all the limitations of the claim to which it refers,” and all of Claims 19-36 refer either directly or indirectly to Claim 18, the only independent claim of the application, any rejection of any of Claims 19-36 under 35 U.S.C. § 103(a) must be based on a reference combination that comprises every limitation of Claim 18. Since, as discussed above, the Beranek/Shurman combination fails to disclose every limitation of Claim 18, and the combination was also solely relied upon by the examiner in the rejection of Claims 19-25, 27, 28, 33, 34, and 36 based on 35 U.S.C. § 103(a), rejection of those claims must fail with the rejection of Claim 18 as discussed above.

In ¶ 5 of the Final Office Action, the examiner rejected Claim 26 of the '192 application under 35 U.S.C. § 103(a) as being unpatentable over the Beranek/Shurman combination, as applied to Claim 18 of the '192 application, in view of Goman et al., U.S. Pat. No. 6,622,464. Since, again, the Beranek/Shurman combination fails to disclose every limitation of Claim 18, this rejection of Claim 26 under 35 U.S.C. § 103(a) must also fail.

In ¶ 6 of the Final Office Action, the examiner rejected Claims 29 and 30 of the '192 application under 35 U.S.C. § 103(a) as being unpatentable over the Beranek/Shurman combination, as applied to Claims 23 and 24 of the '192 application, in view of Paytas et al., U.S. Pat. No. 4,987,729 (Paytas). Since, again, the Beranek/Shurman combination fails to disclose every limitation of Claim 18, and Claims 23 and 24 are proper dependent claims from Claim 18, this rejection of Claims 29 and 30, which properly depend from Claims 23 and 24, respectively, under 35 U.S.C. § 103(a), must also fail.

In ¶ 7 of the Final Office Action, the examiner rejected Claims 31 and 32 of the '192 application under 35 U.S.C. § 103(a) as being unpatentable over the Beranek/Shurman combination, as applied to Claims 23 and 24 of the '192 application, in view of Fillman et al., U.S. Pat. No. 6,571,542 (Fillman). Since, again, the Beranek/Shurman combination fails to disclose every limitation of Claim 18, and Claims 23 and 24 are proper dependent claims from Claim 18, this rejection of Claims 31 and 32, which properly depend from Claims 23 and 24, respectively, under 35 U.S.C. § 103(a), must also fail.

The total number of pages enclosed in this submission, including Forms PTO/SB/30 and PTO/SB/92, is nine.

If you have any questions regarding the above remarks or any part of the amended application submitted herewith, please do not hesitate to contact me at 410-409-4289, or via email at wordlloyd@comcast.net.

Sincerely,



Steven S. Lloyd
Registered Patent Agent No. 56,650

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Date